

REMARKS**Status of Claims**

Prior to further examination, applicants respectfully request consideration based on the amendments and remarks made in this Submission. The Office Action mailed November 19, 2004 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-8 and 56-58 were pending in the application, with claims 57 and 58 being withdrawn from consideration. Claims 1, 56, 57, and 58 have been amended and no claims have been canceled or newly added. Therefore, claims 1-8 and 56-58 are pending in the application, with claims 1-8 and 56 presented for consideration.

This Amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

Restriction Requirement

In paragraphs 3 and 4, the Office Action states that claims 57 and 58 are withdrawn as allegedly being drawn to non-elected invention V and VI. However, applicants traverse this restriction requirement since these claims are not drawn to inventions V and VI. Invention group V is directed to a method of electrical communication by a method of network signaling. In contrast, claim 57 is drawn to a computer implemented method of recommending a product selection across a network and should be classified under the same classification as claim 1 which is directed to a system for recommending a consumer product selection across a network. Likewise, claim 58 is directed to a computer program product that is configured to recommend a consumer product selection across a network and should be classified under the same classification as claim 1. Furthermore, there should be no additional searching burden on the examiner since the same prior art would apply equally to each of these claims.

In this context, in cases examined under other classes in the same technology center 3600, these types of claims are routinely examined in the same application. For example, even in the reference (Kolawa) applied in the Office Action, independent claims 1 and 14 recite a computer implemented *method* and *system* for recommending recipes catered to a

particular user's preference. Accordingly, applicants respectfully request the examiner to reconsider and withdraw the restriction requirement with respect to claims 57 and 58 since these claims are all directed to the same invention as claim 1 and no additional search is required to examine these claims.

Claims Objection

Claim 56 is objected to because of an informality. In reply, applicants submit that amended claim 56 addresses this informality and applicants submit that pending claim 56 is unobjectionable.

Prior Art Rejections

In the Office Action, claims 1-8 and 56 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent 6,370,513 to Kolawa et al. (hereafter "Kolawa"). Applicants respectfully traverse this rejection for at least the following reasons.

Independent claim 1 recites, *inter alia*, that (1) a descriptor module that is configured to receive descriptor input regarding the plurality of descriptors of at least a consumer product from at least two independent consumers at two independent nodes, respectively.

Furthermore, (2) this descriptor input (from a plurality of consumers at independent nodes, respectively) is used by a recommendation engine to differentiate the consumer product (e.g., wine) into at least two classes based on a determined correlation between the two classes and each of the descriptors where a weighting term is assigned for each of the descriptors based upon the descriptors ability to sort between the at least two classes. These recited features are not shown by Kolawa.

The final Office Action implies that feature (1) is not disclosed in Kolawa. *First*, the Office Action stated that in paragraph 10 that this feature was not recited in the then pending claims. However, this feature is now positively recited in the currently pending claims. *Second*, the Office Action stated that Kolawa discloses that the retailers provided some descriptor input in col. 5, lines 2-6. However, this disclosure of *retailers* does not disclose the claimed receiving of descriptor input from at least two independent *consumers* at two independent nodes, respectively even under a broadest *reasonable* interpretation standard

applicable to examination of patent claims. Accordingly, at least this claimed feature is not disclosed or suggested by the prior art.

Applicants note that the Office Action states in paragraph 8 that some of the positively recited claimed features are “functional descriptive material” or portion thereof and implies that these features are somehow to be accorded less patentable weight. However, this standard for examination is incorrect at least for computer implemented invention (whether it be claimed as a system, method, or software). MPEP 2106 makes clear that (emphasis added):

If the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine, Office personnel must determine whether the descriptive material is functional descriptive material or nonfunctional descriptive material, as described *supra* in paragraphs IV.B.1(a) and IV. B.1(b). Functional descriptive material is a limitation in the claim and must be considered and addressed in assessing patentability under 35 U.S.C. 103. Thus, a rejection of the claim as a whole under 35 U.S.C. 103 is inappropriate unless the functional descriptive material would have been suggested by the prior art. *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Accordingly, even if the Office Action’s assertion of certain portions being implemented by computer program code (and hence functional descriptive material) is correct, these limitations need to be considered fully in evaluating the patentability of the claimed computer implemented inventions under sections 102 and 103.

Furthermore, the Patent Office (PTO) has the burden of proving each of the claimed features is shown by the prior art. An allegation that claimed subject matter is “obvious” (and even more so for anticipation as alleged here) requires a positive, concrete teaching in the prior art, such as would lead a person skilled in the art to choose the claimed combination from among many that might be comprehended by broad prior art teachings. The PTO’s review court has made it very clear that silence in a reference is hardly a substitute for clear and concrete evidence from which a conclusion of obviousness might justifiably flow. See, e.g., *Application of Burt*, 356 F.2d 115, 121 (CCPA 1966).

In view of the above, applicants respectively submit that feature (1) discussed above is not disclosed or suggested by Kolawa.

Likewise, with respect to feature (2) nowhere does Kolawa teach or suggest using descriptor input received from two or more independent consumers at two or more independent nodes, respectively, and correlating at least two classes by weighting the descriptors based upon each of the descriptor's ability to sort between the at least two classes. Accordingly, this recited feature provides an additional reason for the patentability of independent claim 1.

The dependent claims are also patentable for at least the same reasons as the independent claims on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole.

For example, dependent claim 56 recites that the descriptor module is configured to receive descriptor input including descriptors from an electronic nose signature of a consumer product. Such a feature is not disclosed or suggested by the applied prior art. Accordingly, this recited feature provides an additional reason for the patentability of this claim.

Claims 57 and 58 (which are currently withdrawn) have also been amended so that they are also believed to be allowable for reasons that are similar to that discussed with respect to claim 1.

In view of the foregoing amendments and remarks, applicants submit that the application is now in condition for allowance. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is courteously invited to contact the undersigned attorney at the local telephone number below.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.

Respectfully submitted,

Date April 19, 2005

By Aaron C. Chatterjee

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 945-6117
Facsimile: (202) 672-5399

Michael D. Kaminski
Registration No. 32,904
Aaron C. Chatterjee
Registration No. 41,398
Attorney for Applicant